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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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140	7590	09/29/2008		
LADAS & PARRY LLP 26 WEST 61ST STREET NEW YORK, NY 10023			EXAMINER MATTER, KRISTIN CLARETTE	
			ART UNIT	PAPER NUMBER
			3771	
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			09/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,294

Applicant(s)

NALDONI, MORENO

Examiner

KRISTEN C. MATTER

Art Unit

3771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 9, 10 and 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 9, 10 and 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Action is in response to the Request for Continued Examination filed on 8/19/2008. Claims 1, 9, and 15 have been amended, claims 17-24 have been added, and no claims have been cancelled. Currently, claims 1, 9, 10, and 13-24 are pending in the instant application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 10 claims a central through hole (204). However, there does not appear to be a disclosed embodiment in which the central portion has a plurality of holes (103c) as claimed in independent claim 1 and a large central through hole for housing an ultrasound emitting device (i.e., either there are the plurality of holes 103c or the central through hole 204 but not both) and it is unclear how this embodiment would function with both types of holes.

Claim 16 is dependent on claim 10 and it therefore rejected for the reasons outlined above with respect to claim 10.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 claims a central through hole (204). It is unclear if this through hole is the same as or different from the holes (103c) claimed in claim 1.

Claim 16 is dependent on claim 10 and it therefore rejected for the reasons outlined above with respect to claim 10.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 9, 13-15, and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milstein et al. (US 5,358,467) and in view of Sampson (US 904,650).

Regarding claims 1, 15, and 17-21, Milstein et al. discloses a skin massage device comprising a handset (9) connected to a machine body (21), said handset comprising a chamber (1) closed by a deformable membrane (15) which at least partially adheres to a patient's skin by virtue of a vacuum generated in said chamber by a vacuum generating device (3), wherein the device comprises means (28) for producing a variable vacuum in said chamber to deform said

membrane thereby lifting, folding, compressing, and smoothing the patient's skin (see column 5, lines 25-35), wherein said membrane has a central portion (middle of membrane) having a plurality of aligned, spaced holes (18) for lifting a portion of the skin and two lateral portions (outsides of membrane) that are moveable by the vacuum and each of the lateral portion has through holes (18) and two projections (see Figure 1). Furthermore, because the term "portion" provides no definite structural limitation, depending on how the portions are defined (i.e., central portion runs all the way across the middle of the circular membrane from a bottom view of the device, varying the width of the central portion, etc.) the central portion can be considered to have one central hole and two lateral holes and/or the portions can be considered to extend transversely across the surface of the membrane in a transversely spaced or aligned relationship.

The difference between the instant claims and Milstein et al. is the lateral portions being thicker than said central portion. However, absent a critical teaching and/or a showing of unexpected results from the lateral portions being thicker than the central portion, examiner contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provide thicker lateral portions for allowing more targeted pressure to be applied to the skin. In addition, Sampson discloses a skin massaging device with a rubber membrane in which lateral portions are thicker than a central portion (see Figure 3) in order to provide both a firm pressure and ay yieldable pressure upon the skin (column 2, lines 50-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided Milstein et al.'s device with thicker lateral portions as taught by Sampson in order to provide varying degrees of pressure on the skin.

Regarding claim 9, Milstein et al. discloses that the membrane is removable from the device (column 2, lines 50-60) and therefore it is inherently disposable because it is capable of being thrown away by a user if broken or worn out.

Regarding claims 13 and 14, Milstein et al. discloses means for activating and presetting (i.e., programming) the pulsating cycle times as determined by an operator (column 5, lines 30-50).

Regarding claim 22, Milstein et al. discloses that the projections can be "sharp or dull" (column 2, lines 55-60). To the extent that "dull" cannot be considered substantially dome-shaped, examiner contends that the shape of the projections is an obvious design consideration to one of ordinary skill in the art depending on the desired pressure and personal preferences of a user. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided Milstein et al.'s device with substantially dome-shaped projections in order to provide increased comfort or a desired pressure pattern to a user.

Claim 10, as best understood by the examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over Milstein et al. as applied to claims 1, 9, 13-15, and 17-22 above, and further in view of Jacobs (US 5,665,053). Milstein et al. discloses central and lateral through holes (18) but is silent as to an ultrasound emitting device. However, Jacobs teaches an endermology device comprising a vacuum source and an ultrasound generator for applying ultrasonic wave energy to increase the breakdown of subcutaneous fatty tissue (col. 1, lines 30-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Milstein et al. device to include an ultrasound emitting device as suggested and

taught by Jacobs, for the purpose of providing means to perform endermology that utilizes ultrasonic wave energy to increase the breakdown of subcutaneous fatty tissue (col. 1, lines 30-67). In addition, it appears as though the device of Milstein et al. would perform equally well with an ultrasound emitting device because ultrasound devices are commonly used in conjunction with suction-type massaging devices and there appears to be no structure in Milstein et al. that would prevent the addition of an ultrasound device.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milstein et al. as applied to claims 1, 9, 13-15, and 17-22 above, and further in view of Fang (US 5,377,701). Milstein et al. is silent as to the membrane having a convex central portion and concave lateral portions. However, this shape is well known and commonly used in the art as disclosed by Fang in Figure 4. Therefore, absent a critical teaching and/or a showing of unexpected results from the shape, examiner contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have curved the membrane such that the central portion was convex and the lateral portions were concave in order to apply a specific pressure pattern and to focus the suction of the vacuum on the skin under the central area.

Claim 16, as best understood by the examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over Milstein et al. and Jacobs as applied to claim 10 above, and further in view of Frenkel et al. (DE 4304091). Milstein et al. as modified by Jacobs is silent as to a collar although Jacobs discloses the ultrasound generator can be attached within the housing and adjacent to and

surrounding the center of the user interface (see figure 3B elements 40c and 40b and column 1, lines 49-51). However, Frenkel discloses a suction massage device including a collar around a central through hole (see Figure 1 where membrane 3 attaches to the central bore area 2b).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the modified Milstein et al. device with a collar as taught by Frenkel et al. such that the ultrasound emitting device is attached to a central internal part of the housing (i.e., the collar of Frenkel), as suggested and taught by Jacobs, for the purpose of providing a well known means to hold an ultrasonic device for utilizing ultrasonic wave energy to increase the breakdown of subcutaneous fatty tissue. In addition, it appears as though the modified device of Milstein et al. would perform equally well with an ultrasound generator attached to a collar as taught by Frenkel et al.

Response to Arguments

Applicant's arguments with respect to claims 1, 9, 10, and 13-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2007/0066919 is cited to show another wavy membrane used in a massage device (Figure 15).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTEN C. MATTER whose telephone number is (571)272-5270. The examiner can normally be reached on Monday - Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kristen C. Matter/
Examiner, Art Unit 3771

/Justine R Yu/
Supervisory Patent Examiner, Art Unit 3771